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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,971	11/08/2005	Hans Westmijze	13877/16301	8201

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER	
HUHN, RICHARD A	
ART UNIT	PAPER NUMBER
1796	
MAIL DATE	DELIVERY MODE
09/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,971	WESTMIJZE ET AL.	
	Examiner	Art Unit	
	RICHARD A. HUHN	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 August 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Any rejections and/or objections made in the previous Office action and not repeated below are hereby withdrawn.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

3. The grounds of rejection set forth below for claims 1-12 are the same as those set forth in the previous Office action mailed on 24 April 2009. For this reason, the present action is properly made final.

Claim Rejections - 35 USC § 112

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. This rejection was adequately set forth in paragraph 5 of the Office action mailed on 24 April 2009, and is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. Claims 1-8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,384,155 (herein "Van Swieten"), as evidenced by

the Akzo-Nobel product data sheets for Trigonox EHP and Trigonox 187 and as further evidenced by the Remarks filed by Applicant on 13 April 2009.

7. This rejection was adequately set forth in paragraphs 8-22 of the Office action mailed on 24 April 2009, and is incorporated here by reference.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Swieten as applied above, in view of US Patent No. 6,274,690 (herein "Hoshida").

9. This rejection was adequately set forth in paragraphs 23-25 of the Office action mailed on 24 April 2009, and is incorporated here by reference.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Swieten.

11. This rejection was adequately set forth in paragraphs 26-28 of the Office action mailed on 24 April 2009, and is incorporated here by reference.

Response to Arguments

12. Applicant's arguments filed 23 July 2009 (herein "Remarks") and 19 August 2009 have been fully considered, and they are persuasive in part.

13. It is noted that Applicant's arguments in the remarks filed on 19 August 2009 are the same as those filed on 23 July 2009. Therefore, both sets of remarks are addressed below, although page references are only made to the Remarks filed on 23 July 2009.

14. Regarding the objection to claims 4 and 9: Applicant argues (page 4 of Remarks) that the claims are properly numbered. This argument is persuasive, and the objection has been withdrawn.

15. Regarding the rejection of claims 1-12 under 35 USC 112, second paragraph, as indefinite: Applicant argues that the specification provides a sufficient standard for ascertaining the "safely useable amount" of initiator. Applicant notes (page 5 of Remarks), "the 'safely useable' amount…relates to the amount of initiator that would be used when the polymerization process is run at its maximum rate with all initiator being added at the start of the polymerization process." This argument is found unpersuasive for the following reasons.

16. Firstly, it is unclear how the safely useable amount can be correlated to the reaction's maximum rate. Presumably, the reaction can be run at a rate that is faster than the safest maximum rate. Therefore, the *maximum* rate would necessarily be unsafe. It is not clear from Applicant's statement how the maximum rate of reaction can be used to determine safely useable amount of initiator.

17. Secondly, it is unclear from the wording of Applicant's argument if Applicant is implying that the maximum rate occurs when all the initiator is added at the start of the polymerization process. If this is the case, then a qualitative limitation such as "safely useable amount" would be unnecessary, as 90% of the amount which causes the maximum rate would simply be 90% of the initiator. Applicant's reference to page 2 lines

30-33 of the present specification is acknowledged; however, this portion of the specification does not make reference to a "safely useable amount" of initiator.

18. Thirdly, it is noted that there are no specific examples in the present specification of unsafe amounts of initiator, or of unsafe reaction rates. Although it is clear from the specification that there exists a maximum safely useable amount of initiator, in the absence of evidence of what this amount would be, or evidence of what an unsafe amount would be, a person of ordinary skill would be unable to ascertain the full scope of the presently claimed subject matter. That is, a person of ordinary skill would not be able to identify what amounts of initiator qualify as safe or unsafe based solely upon the present indication that there exists a maximum safely useable amount of initiator.

19. Regarding the rejection of claims 1-8, 11, and 12 under 35 USC 103(a) as unpatentable over Van Swieten as evidenced by the Trigonox data sheets and Applicant's remarks filed 13 April 2009: Applicant argues (first full paragraph on page 7 of Remarks) that Van Swieten discloses the addition of a second initiator after 12% of the monomer has been polymerized. The examiner and Applicant previously acknowledged this point. This argument only appears to indicate that Van Swieten is not anticipatory. However, the reference was not relied upon for an anticipation rejection. This argument does not appear to address the examiner's assertion that the point at which the initiator is dosed in the method of Van Swieten is "close enough" to the presently claimed point such that a person of ordinary skill would expect similar results, nor does it appear to address the examiner's assertion that the point at which the

initiator is dosed is a result effective variable. It is noted that the motivation to modify Van Swieten to arrive at the presently claimed invention does not come from an express teaching, suggestion, or motivation from the reference itself (TSM test), but rather from the ordinary skill and creativity in the art, including the ability to perform ordinary optimization of a reaction process.

20. Applicant further argues (first full paragraph on page 8 of Remarks) that the present invention provides a process with better control of the heat of polymerization. However, the modification of Van Swieten which was previously presented would lead to a process which meets the limitations of the present claims. Therefore, the modified process of Van Swieten would necessarily possess the alleged beneficial effects regarding control of the heat of polymerization.

21. Applicant further argues (second full paragraph on page 8 of Remarks) that the present invention does not entail any changes to the physical properties of the polymer. Firstly, it is noted that Applicant has not provided any evidence to this effect. That is, Applicant has not provided any evidence or reasoning that the modification of Van Swieten which was previously presented would result in materially significant physical changes to the polymer. Secondly, it is noted that the present claims do not contain any limitations drawn to the properties of the polymers produced by the present invention. Therefore, any differences in the physical properties of the polymers of Van Swieten and those of the present invention are not pertinent to the analysis applied here if those differences are not reflected in the limitations of the claims. Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

22. Applicant has further submitted a Declaration on 19 August 2009, which includes experimental results from a repetition of Example F from Van Swieten. Specifically, the Declaration establishes that the second initiator is added after 12% of the monomer has been reacted. The examiner and Applicant previously acknowledged this point. This evidence only appears to indicate that Van Swieten is not anticipatory. However, the reference was not relied upon for an anticipation rejection. This evidence does not appear to contradict or refute the examiner's assertion that the point at which the initiator is dosed in the method of Van Swieten is "close enough" to the presently claimed point such that a person of ordinary skill would expect similar results, nor does it appear to contradict or refute the examiner's assertion that the point at which the initiator is dosed is a result effective variable.

Conclusion

23. This action is properly final because the claims are rejected on the same grounds as set forth in the previous Office Action mailed on 24 April 2009. Accordingly, THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). See MPEP § 706.07(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. This action is a final rejection and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

26. If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

27. If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

28. A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD A. HUHN whose telephone number is (571) 270-7345. The examiner can normally be reached on Monday to Friday, 8:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. H./
Examiner, Art Unit 1796

/David Wu/
Supervisory Patent Examiner, Art Unit 1796